UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BIRENDRA N. AGARWALA, ERIC M. COKER, ANTHONY CORREALE, JR., HAZARA S. RATHORE, TIMOTHY D. SULLIVAN, and RICHARD A. WACHNIK

Appeal No. 2005-0265
Application No. 09/871,883

ON BRIEF

Before KIMLIN, GARRIS, and WALTZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is hereby remanded, via the Office of the Director for Technology Center 2800, to the examiner for appropriate action consistent with our comments below.

We consider the brief, filed by the appellants on June 12, 2003, to be defective for failing to comply with the requirements

of 37 CFR § 1.192(c)(2002), which was the regulation in force on the filing date of the brief.

Specifically, the "**SUMMARY OF INVENTION**" portion of this brief (see pages 2-6) fails to comply with Section 1.192(c)(5) because no drawing reference characters have been used in explaining the invention defined by the appealed claims. This failure is significantly burdensome to a resolution of the subject appeal. This is because the drawing comprises 17 pages with 33 figures which display various aspects of 4 different embodiments of the appellants' disclosed invention. Further, this burden is exacerbated by the fact that 6 independent claims are included in the 27 claims on appeal and by the fact that these appealed claims have been divided by the appellants into 7 distinct groups to be assessed on this appeal (see pages 7-8 of the brief).

In this last mentioned regard, it appears that the brief also is defective in failing to comply with the "**GROUPING OF CLAIMS**" and the "**ARGUMENT**" requirements of Section 1.192(c)(7) and (8). That is, the "**GROUPING OF CLAIMS**" portion of the brief on pages 7-8 appears to be inconsistent with the "**ARGUMENT**" portion of the brief on pages 9-36. This is because a number of

claims which are commonly grouped in the "**GROUPING OF CLAIMS**" portion of the brief are grouped and argued separately in the "**ARGUMENT**" portion of the brief. For example, independent claims 10, 20 and 25 are grouped together in the "**GROUPING OF CLAIMS**" portion (page 7) but are separately grouped and argued in the "**ARGUMENT**" section on pages 14-17 (claim 10), pages 19-22 (claim 20), and pages 23-26 (claim 25).

In light of the foregoing, we remand this application so that the examiner can mail to the appellants a notice that their brief is defective for the reasons set forth above. In rectifying these defects, the appellants are required to file a replacement brief which complies with current regulation 37 CFR § 41.37 (September 2004) concerning submission of an appeal brief. Section 41.37(c)(1)(v) and (vii) are particularly relevant to the aforenoted defects.

An additional reason compels us to remand this application. On page 10 of the reply brief filed Nov. 14, 2003, the appellants allege that the examiner's answer has not rebutted arguments presented in the principal brief relating to claims 32 and 33 as well as claims 34 and 35. Under the regulation existing at the

time this reply brief was filed, the examiner was not permitted to respond to this allegation by way of a supplemental answer. However such a response is expressly permitted by current regulation 37 CFR § 41.43 (September 2004). Therefore, upon receipt of the appellants' previously discussed replacement brief, the examiner must respond to the allegation in question by preparing a supplemental answer compliant with our current regulation in which he rebuts the arguments concerning claims 32-35 or specifies the portion of his original examiner's answer that he considers to rebut these arguments.

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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is ***not*** made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

REMANDED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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BRADLEY R. GARRIS) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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THOMAS A. WALTZ)
Administrative Patent Judge)

BRG/hh

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